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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/967,321	10/01/2001	Jonathon Michael Blackburn	0623.0860002/LBB/Y-W	4288

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EXAMINER	
LAM, ANN Y	
ART UNIT	**PAPER NUMBER**
1641	

DATE MAILED: 07/27/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/967,321	BLACKBURN ET AL.	
	Examiner	Art Unit	
	Ann Y. Lam	1641	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *10 June 2004*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-15* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☐ Claim(s) _____ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☒ Claim(s) *1-15* are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

This Office action follows a letter by Applicant stating that Applicant never received the Office action mailed on March 25, 2004. The Office action of March 25, 2004, was a first action on the merits. However, upon reconsideration, Examiner believes that a restriction requirement is appropriate as set forth below. To expedite prosecution, Examiner is replacing the non-final action of March 25, 2004 with the restriction requirement below since a final action has not been made and Applicant never received the non-final action of March 25th.

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 1-4, drawn to a method for making a protein array, classified in class 435, subclass 7.9.

II. Claims 5-7, drawn to a protein array, classified in class 436, subclass 524.

III. Claims 8-9, 11 and 15, drawn to a method of using the array (protein/compound or protein/protein interactions), classified in class 435, subclass 6.

IV. Claims 10 and 11, drawn to a method of using the array (protein/nucleic acid interaction), classified in class 435, subclass 7.8.

V. Claim 12, drawn to any use of the array for screening antibodies, classified in class 436, subclass 518.

VI. Claim 13, drawn to a method for making an antibody array, classified in class 435, subclass 7.92.

VII. Claim 14, drawn to a method of using the array of claim 13, classified in class 435, subclass 7.1.

Inventions I and II and are related as process of making and product made. Also, inventions II and VI are related as process of making and product made.

The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)).

In the instant case, as to inventions I and II, the product as claimed can be made by another and materially different process, such as by a process that tags a full length protein at either the N- or C- terminus, that is, without the steps of cloning and expressing the protein.

As to inventions II and VI, the product as claimed can be made by another and materially different process, such as by a process that does not require the use of an antibody.

Inventions I and (III-VII) are unrelated and patentably distinct and independent inventions. Also, inventions III and VI are unrelated and patentably distinct and independent inventions. Moreover, inventions IV and VI are unrelated and patentably distinct and independent inventions. Furthermore, inventions V and VI are unrelated

and patentably distinct and independent inventions. Also, inventions VI and VI are unrelated and patentably distinct and independent inventions.

Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01).

In the instant case, as to inventions I and (III-VIII), the different inventions the inventions are not disclosed as capable of use together and they have different modes of operation, different functions and different effects because invention I is a method for making a protein array and inventions III, IV V and VII are a method of using an array and invention VI claims that the array comprises antibodies, whereas, invention I does not.

As to inventions III and VI, the different inventions are not disclosed as capable of use together and they have different modes of operation, different functions and different effects because invention III is a method of using an array and invention VI is a method for making an array.

As to inventions IV and VI, the different inventions are not disclosed as capable of use together and they have different modes of operation, different functions and different effects because invention IV is a method of using an array and invention VI is a method for making an array.

As to inventions V and VI, the different inventions are not disclosed as capable of use together and they have different modes of operation, different functions and

different effects because invention V is a method of use of an array and invention VI is a method for making an array.

As to inventions VI and VII, the different inventions are not disclosed as capable of use together and they have different modes of operation, different functions and different effects because invention VI is a method for making an array and invention VII is a method of using an array.

Inventions II and (III-V and VII) are unrelated and patentably distinct and independent inventions. Inventions III and (IV, V, VII) are unrelated and patentably distinct and independent inventions. Also, inventions IV and (V, VII) are unrelated and patentably distinct and independent inventions. Moreover, inventions V and VII are unrelated and patentably distinct and independent inventions.

Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01).

As to inventions II and (III-V and VII), the different inventions are not disclosed as capable of use together and they have different modes of operation, different functions and different effects since invention II is a product claim and inventions (III-V and VII) is a method of using an array, and invention VI is a method for making an array.

As to inventions III and (IV, V, VII), invention IV requires the step of bringing nucleic acid probes into contact with an array, whereas, invention III does not. Inventions V and VII requires the use of antibodies, whereas invention III does not.

As to inventions IV and (V, VII), invention IV requires nucleic acid probes, whereas invention VII does not. Invention VII require the use of antibodies, whereas invention IV does not.

As to inventions V and VII, invention VII requires an antibody array, whereas invention V does not.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

Because these inventions are distinct for the reasons given above and the search required for one group is not required for any of the other groups, restriction for examination purposes as indicated is proper.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ann Y. Lam whose telephone number is 571-272-0822. The examiner can normally be reached on M-Sat 11-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Long Le can be reached on 571-272-0823. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A.L.

CHRISTOPHER L. CHIN
PRIMARY EXAMINER
GROUP ~~1800~~ 1641
7/12/04